

**REMARKS**

Claims 1-15 are in the case.

Claims 1-15 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has requested a definitive explanation of the claims in light of the language in claim 1. With all due respect the rejection is traversed, as Applicant believes the definitive explanation is present within the claim, specification and prior response dated March 14, 2005.

Claim 1, for example, teaches a "film...having a smooth surface [without adhesive coating, which is] "capable of removably adhering to a textured surface..." Thus, the statement in the Response dated March 14, 2005, "[t]he smooth surface...is a smooth side of a film that has adhesive properties."

Accordingly, Applicant submits, it is clear that the first side of the film of the claim does not have a coating but has a smooth surface with adhesive properties.

Withdrawal of the rejection is respectfully requested.

Claims 1-4 and 6-15 have been rejected under 103(a) as being unpatentable over Gotoh et al., U.S. Patent No. 5,286,781 ("Gotoh") in view of Harvie et al., U.S. Patent No. 5,693,405 ("Harvie.") Applicant notes that, although the Examiner listed claims 1-4 and 6-13 on page 3 of the Office Action, on page 5 of the Office Action, claims 14 and 15 are addressed as apparently rejected, under the same references. Accordingly, Applicant assumes the 103(a) rejection goes to claims 14 and 15 as well.

As the Examiner notes, Gotoh fails to explicitly teach forming a second side of a film with a rough surface, as is taught by claim 1. Gotoh's adhesive coating is provided

on a base material, of various compositions. Therefore, references in Gotoh are to a back surface of a base material and Gotoh is concerned with additives to that base material. Those additives provide the necessary characteristics to prevent blocking and the like.

For example, in its Background of the Invention, Gotoh describes the problem as follows:

Pressure sensitive adhesive tapes or sheets comprise a base material and a pressure sensitive adhesive layer formed thereon. These tapes or sheets are generally wound up in the form of a coil with the pressure sensitive adhesive layer inside to form rolls. In these rolls, the pressure sensitive adhesive layer as an upper layer closely adheres to the back surface of the base layer as a lower layer under relatively strong adhesion. It is hence difficult to unwind or peel off the wound tape or sheet for use as things are.

Therefore, the back surface of the base material has usually been subjected to so-called releasability-imparting treatment...As such a releasability-imparting treatment, it has been often used to date to apply a release agent to the back surface of a base material in advance.

It is however very difficult to give to the release agent contradictory properties such that it is caused to firmly adhere to the back surface of the base material, but made liable to suitably separate from the pressure sensitive adhesive layer. Therefore, it is necessary to use a special release agent, to coat the back surface of the base material with a primer, or subject it to a corona discharge treatment prior to the coating of a release agent.

Accordingly, it should be noted that Gotoh's teaching, disclosure and reference is only to a *release agent* as being state of the art - "Therefore, *it is necessary* to use a

special release agent, to coat the back surface of the base material with a primer, or subject it to a corona discharge treatment prior to the coating of a release agent.” *Id.*

Gotoh proposes to substitute such release agents with its own composition:

An object of the present invention is to provide a pressure sensitive adhesive composition, which can provide rolled pressure sensitive adhesive tapes by using it, said tapes exhibiting good removability, having good unwinding ability, i.e., rerolling ability even when making no use of any release agents...

Therefore, Gotoh is teaching that a chemical solution – the “release agents” of the art – can be replaced with its chemical solution in order to prevent blocking. What one skilled in the art would learn from Gotoh is that it is possible to replace the teachings of the prior art, calling for a release agent, with another chemical solution, the composition of Gotoh. In either situation, a chemical solution, a release agent, is replaced with another chemical solution, a composition.

It is submitted, therefore, that to replace Gotoh’s chemical composition teachings with a mechanical solution, such as a rough surface taught by claim 1, would contradict the teachings of Gotoh. In other words, Gotoh only teaches that a chemical composition is the solution to blocking and wrinkling. Therefore, one skilled in the art would be motivated to use a chemical solution. One skilled in the art would not ignore Gotoh’s chemical composition teachings and decide instead to use a mechanical solution; a mechanical solution would contradict the entirety of Gotoh’s teachings that a chemical solution is the only solution.

Nor would one skilled in the art be motivated to perform the combination of Gotoh and Harvie that the Examiner suggests. First, as was noted above, Gotoh’s

solution is chemical, not mechanical. Harvie teaches that a film may be imprinted, etc. with various indicia, etc.

In order to perform the combination the Examiner suggests, a practitioner would first have to create a film according to the teachings of Gotoh. Second, upon noticing that that film, created according to the teachings of Gotoh, actually contradicts Gotoh, by still blocking and/or wrinkling, the practitioner would most likely toss Gotoh's composition away, as it simply did not work. In the alternative, the practitioner would likely combine a release agent with Gotoh's composition (if possible), thus combining the art taught by Gotoh with the solution taught by Gotoh. It is submitted that the practitioner would absolutely *not* attempt to provide a solution such as Harvie's to the Gotoh composition for the simple reason that Gotoh's composition simply appears flawed – it blocks and wrinkles when Gotoh states it should not. In other words, the practitioner in the art would simply assume that Gotoh's composition is flawed because it does not act in accordance with its teachings. To assume, as the Examiner does, that instead of tossing Gotoh's teachings aside, the practitioner would spend more time on the composition and try an entirely different, mechanical solution – a rough surface – in order to repair the problems that Gotoh's composition created, is to simply engage in impermissible hindsight reconstruction.

Accordingly, it is submitted that the rejection to independent claim 1 and its dependant claims 2-4 and 6-15 should be withdrawn. Early allowance of the claims is earnestly solicited.

The Examiner has also rejected claim 5 over Gotoh, in view of Harvie and Okumura, U.S. Patent No. 6,407,788 ("Okumura.") Applicant respectfully traverses the

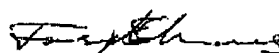
rejection. Claim 5 depends from claim 1 and shares all the limitations of the base claim. As Applicant has noted above, the proposed Gotoh-Harvie combination does not work, and in fact contradicts the teachings of Gotoh, the principal reference. The addition of Okumura does not cure the failure of the proposed Gotoh - Harvie combination either. Accordingly, Applicant respectfully requests the withdrawal of the rejection to claim 5 and early allowance of the claim.

Conclusion

Claims 1- 15 define patentable subject matter over the art of record and are not anticipated by nor obvious in view of the references of record. A Notice of Allowance is respectfully solicited.

Respectfully Submitted,

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